

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
James Gross et al.

Application No.: 09/774,248

Filed: January 30, 2001

Art Unit: 3761

For: ABSORBENT PRODUCTS WITH IMPROVED
VERTICAL WICKING AND REWET
CAPABILITY

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants submit this second Reply Brief in response to the Examiner's second Answer dated October 9, 2007, pursuant to the provisions of 37 C.F.R. § 41.41.

Appellants refer back to the previously submitted a Request for Oral Hearing before the Board of Patent Appeals and Interferences on November 22, 2005, which was previously filed along with the requisite fee. Appellants resubmit herewith a second Request for Oral Hearing, however, Appellants have been informed by the USPTO that no additional fee will be necessary, as the fee was previously paid. As such, Appellants believe that no fee is due at this time. If however additional fees are due, the Commissioner is hereby authorized to charge payment of fees or to credit any overpayment associated with this communication to Deposit Account No. 02-4377.

In response to the Examiner's Answer of October 9, 2007, Appellants respectfully request that the Examiner acknowledge receipt and entry of the following reply brief, or alternatively, withdraw the final rejection and pass the case to issuance.

I. Claim Amendments

The Examiner has correctly noted that the pending claims do not presently recite "physically independent". (See Examiner's Answer, 9/22/2005, page 8; 10/09/07, page 8). As summarized in the Appeal Briefs dated June 24, 2005 and August 4, 2006, respectively, the proposed amendments submitted in response to the final Office Action were not entered. Under MPEP 1206, claims on appeal are restricted to those claims in the prosecution as they appeared at the time of the appeal. Since Appellants claim amendments in response to the Final Office Action were not entered by the Examiner, the claims are required to be listed without the previously proposed amendment.

II. Interpretation of References

The Examiner has taken the position that Appellants have misunderstood the Examiner's interpretation of the references. The Examiner contends that Appellants' case law support for claim interpretation is limited to dependent claims and not to independent claims. However, Appellants submit that the Examiner is incorrect in this position.

Appellants' reliance on *Inverness Med. Switz. GmbH v. Princeton Biomeditech Corp.*, 309 F.3d 1365, 1371, 64 U.S.P.Q.2d (BNA) 1926, 1931 (Fed. Cir. 2002) was not misplaced. The Examiner attempts to distinguish Appellants' reliance on *Inverness* on the grounds that Appellants' arguments relate to the use of a claim term that appears in two independent claims, and that *Inverness* only deals with the similar construction of terms in dependent claims. The Examiner's attempt to distinguish on this ground, however, is misplaced. As the case law clearly demonstrates, a claim term should be interpreted consistently throughout a patent and applies to the entire patent and all of the claims, not only the dependent claims.

Appellants here provide additional case law for support. For example, in *Southwall Techs. Inc. v. Cardinal IG Co.*, the court explained "[t]he fact that we must look to other claims using the same term when interpreting a term in an asserted claim mandates that the term be

construed consistently in all claims.” 54 F.3d 1570, 1579, 1584, 34 U.S.P.Q.2d (BNA) 1673, 1679 (Fed. Cir. 1995). *See also, Research Plastics, Inc. v. Federal Packaging Corp.*, 2005 U.S. App. LEXIS 17492 (Fed. Cir. Aug. 18, 2005) (presumption of consistent use of terms throughout a patent and upholding a district court’s interpretation of the claim term “rear end” as a consequence of this presumption); *CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146, 1160, 42 U.S.P.Q.2d (BNA) 1577, 1586 (Fed. Cir. 1997) (claim terms must be construed consistently between claims and, thus, interpreting the term “elasticity” in one independent claim in a manner consistent with its use in another independent claim) (citing *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 632, 3 U.S.P.Q.2d (BNA) 1109, 1113 (Fed. Cir. 1987)).

The Examiner also maintains that Appellants are interpreting the layers in Hammons by vocabulary only -- that Appellants are not understanding the Examiner’s statement that “names given to layers are just that”. However, Appellants submit that one skilled in the art would appreciate that named layers have specific meanings in the art -- meanings that cannot be disregarded. If the prior art uses terms as mere window dressing, then the purpose of designated vocabulary would have no meaning.

Nonetheless, Appellants have consistently looked to the function of the named layers as they are used in Hammons, while appreciating his labeling scheme. Contrary to the Examiner’s incorrect assertions, Appellants have reviewed each of the functions of each layer disclosed in Hammons during prosecution to determine that the cited art is in fact different from the claimed invention, and thus not anticipating or obvious to the claimed invention. Hammons has consistently referred to a topsheet, backsheet, and an absorbent core. Within the absorbent core, Hammons consistently refers to an acquisition layer, storage distribution layer, and an indicator layer. Each of the specified layers has a specific function as previously summarized in the Appeal Briefs dated June 24, 2005 and August 4, 2006. Furthermore, Hammons discloses a specific arrangement of these layers to form an absorbent product different from the claimed invention.

Appellants arguments stand that the reversal of the rejection over Hammons is required.

III. Obviousness Rejection

Lastly, the Examiner has stated that Appellants have misconstrued the obviousness rejection under 35 U.S.C. § 103 over Hammons, and that there is no present rejection of obviousness over Hammons in view of Georger and Aziz. According to the Examiner, the standing rejection is not inclusive of Georger and Aziz.

Appellants have reviewed the recitation of the rejections and note that the Examiner rejected the claims over Hammons, with reliance of Georger and Aziz as examples of specific low rewt values. Appellants submit that the interpretation of the rejection is correct, and even if the rejection is viewed in light of Hammons alone (without reference to Georger or Aziz), the substance of the rejection is not changed. Accordingly, Appellants arguments stand and are equally applicable to Hammons alone.

IV. Information Disclosure Statement

The Examiner has pointed out what appear to be corrections to the procedural history. While not of consequence to the substantive issues on appeal, to the extent that clarification is necessary, Appellants agree that the Office Action dated April 23, 2004 indicated that references cited therein were not considered due to an incomplete submission. Appellants then resubmitted the IDS on July 23, 2004 as agreed during a May 23, 2004 telephone discussion between the Examiner and the undersigned. The Examiner repeated that the IDS submission was incomplete in the Office Action dated November 2, 2004, and stated “[t]o have these documents considered, the applicant should resubmit the form listing these documents along with proof of receipt form the Office for the initial submission.” (November 2, 2004 Office Action, page 2). Therefore, Appellants submitted the IDS documents with the February 2, 2005 amendment.

V. Conclusion

For the foregoing reasons, the cited prior art references would not have rendered the presently claimed invention anticipated or obvious. The rejections of claims 1-13, 29-30 and 35-36 should be reversed by the Board.

Dated: November 16, 2007

Respectfully submitted,

By Sandra Lee
Sandra S. Lee
Registration No.: 51,932

BAKER BOTTS LLP
30 Rockefeller Plaza
New York, New York 10112-4498
(212) 408-2500
(212) 408-2501 (fax)
Attorneys/Agents For Applicant